

REMARKS

I. General

Applicants respectfully request reconsideration of the present application.

II. Disposition of the Claims

Claims 1-10 were previously cancelled, without prejudice or disclaimer.

Claims 11-15 were previously presented and examined.

III. Claim Rejections – 35 U.S.C. § 103

The Office rejected claims 11-15 for being obvious over Ichikawa (US Patent 6,786,956) in view of Ikeda (US 2004/0207702). (Office Action at page 2). Applicants respectfully traverse on the ground that Ichikawa (US Patent 6,786,956) cannot be used for the purpose of rejecting the claims under 35 U.S.C. §103.

35 U.S.C. §103 (c) provides:

(1) Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Although it has an earliest claimed priority date of December 28, 2000 (date of its Japanese counterpart, which was published on July 19, 2002), US Patent 6,786,956 has the same inventor, Shuji Ichikawa of Japan, and is assigned to the same assignee, Mitsubishi Pencil Co., Ltd as shown in the records, as the present application.

Application 10/528,404 and Patent 6,786,956 were, at the time the invention of Application 10/528,404 was made, both owned by the same assignee, Mitsubishi Pencil Co., Ltd. This statement establishes sufficient evidence of common ownership. MPEP § 706.02 (I)(2).

Furthermore, Applicants submit Declarations under 37 C.F.R. §§ 1.131 and 1.132 of Shuji Ichikawa (Exhibit A), and Shuji Ichikawa and Miyuki Shoji (Exhibit B), providing further evidence of common ownership of this application. Applicants, therefore, respectfully request reconsideration of the present application in view of submitted Declarations.

CONCLUSION

It is believed that the present application is in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is believed that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. § 1.136 and authorize payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date April 18, 2008

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By 

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EXHIBIT A

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Shuji ICHIKAWA et al.

Title: OIL-BASED INK COMPOSITION FOR OIL-BASED
BALLPOINT PEN

Appl. No.: 10/528,404

Filed: 4/14/2005

Examiner: Veronica Faye Faison-Gee

Art Unit: 1793

Conf. No.: 2536

DECLARATION UNDER 37 C.F.R. §1.132

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

I, Shuji ICHIKAWA, do hereby declare as follows.

1. I am a co-inventor named in the captioned application 10/528,404, and am employed by the current assignee of the application.

2. I understand that the PTO rejected the pending claims 11 - 15 in the above-captioned application over U.S. Patent 6,786,956 issued to Shuji ICHIKAWA in view of Ikeda (US 2004/0207702) in a final office action dated November 28, 2007.

3. I conceived and was the inventor of the invention of U.S. Patent 6,786,956.

4. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements are made with knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title XVIII of the United States Code and that willful false statements may jeopardize the validity of this Application for Patent or any patent issuing thereon.

Shuji Ichikawa
Shuji ICHIKAWA

March 27, 2008
Date

EXHIBIT B

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Shuji ICHIKAWA et al.

Title: OIL-BASED INK COMPOSITION FOR OIL-BASED
BALLPOINT PEN

Appl. No.: 10/528,404

Filed: 4/14/2005

Examiner: Veronica Faye Faison-Gee

Art Unit: 1793

Conf. No.: 2536

DECLARATION UNDER 37 C.F.R. §1.131

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

We, Shuji ICHIKAWA and Miyuki SHOJI, hereby declare
that:

1. We are co-inventors of the subject matter that is
claimed in the above-captioned patent

application 10/528,404.

2. We understand that the PTO rejected the pending claims 11 - 15 in the above-captioned application over U.S. Patent 6,786,956 issued to Shuji ICHIKAWA in view of Ikeda (US 2004/0207702) in a final office action dated November 28, 2007.

3. The above-captioned application 10/528,404 and U.S. Patent 6,786,956, at the time of the invention of the above-captioned application was made, owned by the same company Mitsubishi Pencil Co., Ltd of Japan.

4. We hereby declare that all statements made herein of our knowledge are true and that all statements made on information and belief are believed to be true and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application of any patent issuing thereon.

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Shuji Ichikawa
Shuji ICHIKAWA

March 27, 2008
Date

Miyuki Shoji
Miyuki SHOJI

March 27, 2008